Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID KUPIECKI

Appeal No. 2000-0180
Application No. 08/539,943

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 14, which are all of the claims remaining in this application. Claim 2 has been canceled.

Appellant's invention is directed to a balloon catheter

having a lumen with a port proximal of the balloon through which therapeutic or diagnostic agents may be delivered (specification, page 1, claims 1, 3 and 4). In addition, appellant's invention involves a vaso-occlusive agent delivery assembly (claims 5 through 8 and 14), a method for delivering a vaso-occlusive agent to a desired occlusion site in the body (claims 9 through 12), and a method for isolating a desired site in the body for fluid communication with a port in a catheter (claim 13). Independent claims 1, 5, 9 and 13 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Samson	5,304,198	Apr. 19, 1994
Goy	5,413,581	May 9, 1995

Sugawara et al. (Sugawara), "Experimental Investigations Concerning a New Liquid Embolization Method: Combined Administration of Ethanol-estrogen and Polyvinyl Acetate," 33

Neurol. Med. Chir., 71-76 (Tokyo, February, 1993).

Claims 1, 3, 4 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Samson in view of Goy.

Claims 5 through 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Samson in view of Goy and Sugawara.[1]

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 21, mailed March 17, 1999) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 20, filed December 28, 1998) for the arguments thereagainst.

OPINION

[1]Regarding the examiner's final rejection of claim 7 under 35 U.S.C. § 112, second paragraph, in Paper No. 14 (mailed March 18, 1998), it appears from appellant's comments in the brief (page 4) that this rejection is considered to be "not under appeal" and that appellant has acquiesced in the examiner's position regarding the rejection and will at some later point in time amend claim 7 to overcome the rejection. Based on appellant's comments, we consider that the appeal as to this rejection has been withdrawn by appellant and that the § 112 rejection is not before us for review.

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Prior to our treatment of the examiner's rejections on appeal, we note that on page 4 of the brief appellant has indicated, under the heading "GROUPING OF CLAIMS," that claims 1, 3, 4 and 13 stand or fall together, and that claims 5 through 12 and 14 likewise stand or fall together. Accordingly, in our discussions below we will focus on independent claims 1 and 5, deciding the issues on appeal on the basis of those claims alone. As desired by appellant, claims 3, 4 and 13 will stand or fall together with claim 1, while claims 6 through 12 and 14 will stand or fall with claim 5.

Looking first at the examiner's rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Samson in

view of Goy, we note that on page 4 of the answer the examiner has urged that Samson discloses a medical catheter like that depicted in appellant's invention "except for the delivery lumen with a delivery port proximal to the balloon." To account for this difference the examiner turns to Goy, noting that Goy teaches a balloon dilation catheter used for delivery of drugs and/or contrast medium to the vasculature system via a second lumen (9) in the catheter which has a delivery port or opening (10) located proximal to the balloon (22) so as to allow access to and treatment of blood vessels that branch from main blood vessels. From these teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide a separate lumen for drug and contrast material delivery in the catheter of Samson with a delivery port proximal to the balloon as taught by Goy "since Goy teaches that it is desired in the art of balloon angioplasty to provide a delivery lumen and port proximal the balloon so one can access the branched blood vessels for treatment thereof and since Goy further teaches that balloon catheters can have separate lumens for the guidewire and for infusion of drugs or

other materials" (answer, page 4).

Based on our evaluation of the collective teachings of Samson and Goy from the perspective of one of ordinary skill in the art at the time of appellant's invention, we are in agreement with the examiner. Appellant's position (brief, pages 6-7) that Goy is limited in its teaching to providing an additional open-ended lumen for introduction of contrast media or drugs so as to overcome the disadvantage therein of a catheter having a closed distal end, and thus would not have provided any motivation, much less a suggestion, for modifying the open-ended dilation catheter of Samson to include an additional open-ended lumen as in Goy, is unpersuasive. In this regard, we point to the teaching found in Goy at column 2, lines 49-52, that the catheter therein makes it possible to carry out, independently of one another, measurements or infusions via the additional lumen and control of the pressure in the balloon via the first lumen. In our opinion, this teaching in the Goy reference would have provided ample motivation and suggestion to one of ordinary skill in the art for providing the catheter of Samson with an additional lumen

(9, 10) as in Goy so as to permit measurements and/or independent infusions of drugs or other treatment materials into the vasculature via the additional lumen while at the same time allowing control of the pressure in the inflated balloon via the inflation/wire lumen of Samson during a balloon angioplasty procedure like that mentioned in column 5, lines 18-22, of Samson.

Accordingly, we will sustain the examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) based on the combined teachings of Samson and Goy. Given appellant's grouping of the claims noted above, it follows that claims 3, 4 and 13 will fall with claim 1.

As for the examiner's rejection of claims 5 through 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Samson in view of Goy and Sugawara, we observe that appellant has again argued that there is no motivation to modify the catheter of Samson by adding an additional distally open-ended lumen as disclosed in Goy. In addition, appellant has noted that although Sugawara does mention the use of a dual lumen catheter, it does not describe or show the structure of that device. Thus, appellant concludes that the combination of Samson and Goy in view of Sugawara does not render the invention of claims 5 through 12 and 14 on appeal obvious. For the reasons which we have set forth above in regard to the examiner's rejection of claim 1, we are of the view that the combined teachings of the applied references would have rendered obvious the subject matter of claim 5 on appeal. In

this regard, we note that appellant has not disputed the examiner's combination of Sugawara with the teachings of Samson and Goy, but has instead merely relied upon the same argument presented above that Samson and Goy do not provide any reason, suggestion or motivation for combining their teachings; an argument that we have already found unpersuasive. Accordingly, the examiner's rejection of claim 5 under 35 U.S.C. § 103(a) will likewise be sustained. Given appellant's grouping of the claims (brief, page 4), it follows that claims 6 through 12 and 14 will fall with claim 5.

In light of the foregoing, the decision of the examiner to reject claims 1, 3, 4 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Samson in view of Goy is affirmed, as is the examiner's decision to reject claims 5 through 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Samson in view of Goy and Sugawara.

Under the provisions of 37 CFR § 1.196(b), we also enter the following new ground of rejection against claims 5 through 8 and 14 on appeal.

Claims 5 through 8 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. In particular, we observe that there is no proper antecedent basis in claim 5 for "said catheter" or "said medical catheter" as set forth in line 2 of claim 5. We also remind appellant of the need to amend claim 7 to overcome the lack of a proper antecedent basis for "said guidewire lumen" in that claim.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§

141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosection before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosection before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED, 37 CFR § 1.196(b)

IAN A. CALVERT)

Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
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